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REMARKS – General

Objections to the Drawings:

The most recent Office Action (OA) objects to drawings 1, 3-6 for including reference designators not included in the specification. Applicants note each rejection and response below:

1. FIG. 1, ref. dcs. 4: Applicants have amended the specification to include reference designator 4 as referring to the weld on page 2, first full paragraph.
2. FIGS 3-6, item 323: Applicants have amended the specification to recite a coiled spring as reference designator 323. Due to an inadvertent typographical error, this spring was accidentally labeled 309 in the original specification. This amendment is carried forth throughout the specification.

The OA objects to FIG. 4 as including the cutting action in the –X direction, while FIG. 7 shows it in the +X direction. This has been corrected with an amended FIG. 4, which reverses the –X and +X.

The drawings are objected to as reference designator 309 has been used in the specification to refer to both the recess and a coil spring. This typographical error has been corrected, as noted above.

Objections to the Specification:

The specification is objected to due to three typographical errors. These have been corrected by amendment above.

Claim Rejections - §112:

The OA rejects claims 1-14 and 15-18 as failing to comply with the enablement requirement of 35 USC §112, first paragraph. The OA submits that one of ordinary skill in the art would not be able to make and use the invention in light of Applicants' written

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specification and drawings. The OA makes three such rejections. Applicants respond to each below:

1. First, the OA submits that it is not clear how the moveable belt is coupled to the moveable support.

Applicants note that according to MPEP §2164.01, the test for enablement is that an application "...when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied." *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Thus, the test is whether undue experimentation is required, not whether every minor detail of the invention is explained. "The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation." Emphasis added. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd.* sub nom., *Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). See also *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404.

In determining whether the experimentation is undue, according to the MPEP, the following factors must be considered, inclusively:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and

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(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

MPEP §2164 goes as far as to state that "The specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation." Emphasis added. *In re Borkowski*, 422 F.2d 904, 908, 164 USPQ 642, 645 (CCPA 1970).

Considering the above, including the fact that the specification need not include an example where one could practice the art without undue experimentation, Applicants address these rejections, each in turn. Regarding the coupling of the moveable belt to the moveable support, Applicants begin by noting in FIG. 4 that there is a rectangle shown between the moveable support and the moveable belt, slightly less in width than the moveable support, which is fixedly coupled to the moveable support. This rectangle is the rigid element that couples the moveable belt to the moveable support through an aperture (310 in FIG. 3) in element 304. Note that the moveable belt, as shown in FIG. 3, is wider than this rectangle. Applicants respectfully submit that FIGS. 3 and 4 alone, when viewed by someone of ordinary skill in the art, would allow someone to make and practice the invention without undue experimentation, as it is clear that for the moveable belt to move when the moveable support moves, they must be connected together in some fashion. Applicants respectfully submit that this coupling may be achieved by one of ordinary skill without any undue experimentation. Applicants are willing to submit affidavits to this affect if necessary.

Next, consider the specification. At page 4, lines 9-15, the specification states:

As stated, the moveable belt 305 passes through an aperture 301 in the fixed block 304, and is coupled to a moveable support 307. The moveable support 307, and therefore the attached moveable belt 305, are spring loaded against the fixed block 304 by at least one coil spring 309. The

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coil spring 309 pulls the moveable belt 305 toward the recess 309 when the spring is at rest. A lever 308 coupled to the moveable support 307 allows an operator to open the closed loop 306 by pulling on the lever 308. When the lever 308 is released, the coil spring 309 causes the moveable belt 305 to again pull back into the aperture 310.

While the specification does not designate whether the coupling is a weld, glue, screw or rivet, Applicants respectfully submit that when reading this portion of the specification, combined with the complete mechanical drawings shown in FIGS. 3 and 4, no undue experimentation would be required to couple the moveable belt to the moveable block.

Next, consider some of the factors listed above:

1. The nature of the invention: The invention is a mechanical tool.
2. The state of the prior art: The OA submits that prior art references dating nearly 100 years prior to the filing date are on point, which implies that the OA believes the art to have been in existence for quite a long time.
3. The level of one of ordinary skill: Mechanical tooling makers have been making mechanical devices from steel from complete drawings for quite a long time.
4. The level of predictability in the art: Mechanical devices, including those that are manually operated, tend to be a quite predictable art.
5. The amount of direction provided by the inventor: In addition to the detailed specification, Applicants have included an isometric view of the invention, a top plan view of the invention, a left side view of the invention, and a right side view of the invention.
6. The existence of working examples: Applicants note the existence of a working example in the specification, as well as test data derived from its use in the specification at page 7, line 15, through page 9, line 14.
7. The quantity of experimentation needed to make or use the invention based on the content of the disclosure: Applicants respectfully submit that given the level of detail of the drawings, combined with the specification, there is no

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undue experimentation required to attach the moveable belt to the moveable block. "The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue." *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

For all of the above reasons, including the evidentiary weight that is given to the factors, Applicants respectfully traverse the rejection. Applicants respectfully request reconsideration in light of these comments.

2. The OA states that it is unclear how the moveable support is spring loaded. Applicants respectfully traverse this rejection.

To begin, Applicants note that in FIGS. 3-6, there are two coiled springs (323,400) that are connected between the moveable block and the fixed block. While the OA submits that the springs never contact the moveable block, Applicants respectfully disagree. Applicants note that the pins to which the springs are connected (See FIG. 5 for example) are coupled to the fixed block. As such, given the specification's discussion of these springs spring loading the moveable block, the other end is, to be sure, coupled to the moveable block. Any question as to this fact should be dispelled by the specification which is recited in the following paragraph.

Turning to the specification, Applicants note that at page 4, lines 9-15, the specification states:

As stated, the moveable belt 305 passes through an aperture 301 in the fixed block 304, and is coupled to a moveable support 307. The moveable support 307, and therefore the attached moveable belt 305, are spring loaded against the fixed block 304 by at least one coil spring 309. The coil spring 309 pulls the moveable belt 305 toward the recess 309 when the spring is at rest. A lever 308 coupled to the moveable support 307 allows an operator to open the closed loop 306 by pulling on the lever 308. When the lever 308 is released, the coil

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spring 309 causes the moveable belt 305 to again pull back into the aperture 310.

Next, again, consider the factors:

1. The nature of the invention: The invention is a mechanical tool.
2. The state of the prior art: Again, the OA submits that prior art references dating nearly 100 years prior to the filing date are on point.
3. The level of one of ordinary skill: Mechanical tooling makers have been making mechanical devices from steel from complete drawings for quite a long time.
4. The level of predictability in the art: Mechanical devices, manually operated are quite predictable.
5. The amount of direction provided by the inventor: In addition to the detailed specification, Applicants have included an isometric view of the invention, a top plan view of the invention, a left side view of the invention, and a right side view of the invention. Each view shows at least one spring coupled between the moveable block and the fixed block.
6. The existence of working examples: Applicants note the existence of a working example, as well as data derived from its use in the specification at page 7, line 15, through page 9, line 14.
7. The quantity of experimentation needed to make or use the invention based on the content of the disclosure: Applicants respectfully submit that given the level of detail of the drawings, combined with the specification, there is no undue experimentation required to determine that the coil springs spring load the moveable block.

For all of these reasons, Applicants respectfully request reconsideration of the rejection. Applicants respectfully submit that no undue experimentation is necessary to spring load the moveable block given the specification and drawings. Again, "The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue." *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

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3. The OA submits that it is uncertain how item 403 alone can be considered the leveling means when the recess performs a function in the leveling process. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the rejection being made by the OA is one of enablement. The question of enablement is not whether one or more features in the invention contribute to any particular adjective set forth by Applicants acting as their own lexiconographer, but rather whether one could make and use the invention without undue experimentation. Applicants respectfully submit that FIG. 7 clearly sets forth how element 403 performs a leveling function. Applicants further submit that FIG. 7 illustrates such in a manner that makes the invention practicable without undue experimentation. For this reason, Applicants respectfully submit that the rejection is overcome. Applicants respectfully request reconsideration of the rejection.

The OA makes four rejections per §112, second paragraph. Applicants respond to each, in turn, below.

1. The OA submits that it is unclear how the belt is spring loaded. Applicants respectfully traverse this rejection. Applicants have addressed this issue in detail above, and so will only touch on it here. The springs 323 and 400, which are coupled to pins on the fixed block, and the other end is coupled to the moveable block. Applicants are willing to submit an affidavit attesting to this fact if necessary. Applicants respectfully submit that it is clear to one of ordinary skill in the art that this is the case given the specification cited above. Applicants respectfully request reconsideration of the rejection.
2. The OA submits that the at least one blade traveling parallel to the top surface of the leveling means is unclear. Applicants respectfully traverse this rejection. Applicants respectfully submit that the blade, which is the sharpened, leading edge of the leveling means, travels in parallel to the upper surface (a flat planar section) of the leveling means. Applicants respectfully submit that this is the

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proper way to describe the apparatus. The leveling means could, hypothetically speaking, have a rounded leading edge. In such an embodiment, the top surface (which is included in this hypothetical embodiment) would move across the cell, but the blade would be absent. To properly describe both the cutting edge and the planar top surface, these two terms are used. Applicants respectfully request reconsideration of the rejection.

3. The OA notes that there is insufficient antecedent basis for "the leveling means". This has been changed to the "cutting means" by amendment. Support for the amendment is found in element (d) of claim 15. Applicants respectfully request reconsideration of the rejection in light of the amendment.
4. The OA submits that the meaning of "the leveling means" in claim 16 is unclear. Applicants submit that this is clarified by the amendment to claim 15 above, and respectfully request reconsideration of the rejection in light of the amendment.

Claim Rejections 35 USC §102:

The OA rejects claims 1-3, 7, 8 and 10-13 under §102(b) as being anticipated by Coleman, US Pat. No. 3,675,524. Applicants respectfully traverse this rejection.

In making the traversal, Applicants rely upon MPEP §2131, which states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Emphasis added. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With respect to claim 1 and its dependent claims, Applicants respectfully submit that Coleman fails to teach a means for holding a battery cell. Coleman teaches an adjustable holder for integrated circuit packages that is "...substantially an inverted T-shaped structure having a mounted block forming a part thereof." Coleman, col. 2, lines 73-75. As noted by Applicants, cells may be cylindrical in nature, and such an inverted T-

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shape is incapable of accommodating such cells. Applicants respectfully request reconsideration of the rejection.

With respect to claim 3, Applicants respectfully submit that Coleman fails to teach a leveling means that limits the amount of insertion into the means for holding. Applicants note that Coleman confirms this at col. 3, lines 1-15 when he discusses first inserting the integrated circuit package into the holder, and then adjusting leveling screws. The leveling screws adjust the holder itself, not the amount of insertion into the holder. Applicants respectfully request reconsideration of these rejections in light of these comments.

Claim Rejections under 35 USC §103:

The OA rejects claim 4 over Coleman in view of Markeev et al, US Patent No. 4,077,287, hereinafter "Markeev". Applicants respectfully traverse this rejection.

In making the traversal, Applicants rely upon MPEP §2143 which states, "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations.*" Emphasis added. Applicants respectfully submit that neither Coleman nor Markeev teach a means for holding a battery cell, as is claimed by Applicants in claim 1, from which claim 4 depends. Applicants thus submit that the combination thus fails to teach all of Applicants' claimed limitations. Applicants respectfully request reconsideration of the rejection.

The OA rejects claims 5 and 6 over Coleman in view of Diskin, US Pat. No. 5,135,208. Applicants respectfully traverse this rejection.

In making the traversal, Applicants rely upon MPEP §2143.01, which states, "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in

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the knowledge generally available to one of ordinary skill in the art." Emphasis added. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Applicants respectfully submit that the invention of Coleman is a small device for opening semiconductor integrated circuits, which are often less than a centimeter in diameter. Diskin, by contrast, is an industrial pipe vice, which utilizes a torsion chain, not unlike that found on a chain saw or bicycle. Applicants respectfully submit that there is no motivation found in either of the references to employ a rugged, industrial chain to secure a semiconductor integrated circuit. Similarly, there is no motivation to use a small, inverted T-shaped integrated circuit holder to secure industrial piping. Applicants respectfully request reconsideration of the rejection.

Claim 9 is rejected over Coleman in view of Matych, US Patent No. 1,164,658. Applicants respectfully traverse this rejection.

As noted above, Applicants respectfully submit neither Coleman nor Matych teaches a leveling means that limits the amount of insertion of a battery cell into the means for holding a battery. (Note that claim 7 has been amended to depend from claim 3.) Applicants have noted this fact with respect to Coleman above. Applicants note that Matych merely teaches a groove into which a slug may be inserted (See FIG. 2). There is not a leveling means. As the combination fails to teach all of Applicants' claimed limitations, Applicants respectfully request reconsideration of the rejection.

Claims 15, 16 and 18 are rejected over Coleman in view of Diskin. Applicants respectfully traverse this rejection.

Applicants respectfully submit that neither Diskin nor Coleman teach a blade coupled to the leveling means. Coleman teaches screws that may be twisted to raise or lower an integrated circuit holder. Diskin teaches only a chain vise for pipes. There is no leveling means at all. As the combination fails to teach all of Applicants' claimed limitations, Applicants respectfully request reconsideration of the rejection.

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Claim 17 is rejected over Coleman in view of Diskin, further in view of Makeev. Applicants respectfully traverse the rejection.

Applicants respectfully submit that neither Diskin nor Coleman or Makeev teach a blade coupled to the leveling means. As noted above, Coleman teaches screws that may be twisted to raise or lower an integrated circuit holder. Diskin teaches only a chain vise for pipes. There is no leveling means at all. Makeev teaches an apparatus for cross cutting a strip in to plates, and includes no leveling means. As the combination fails to teach all of Applicants' claimed limitations, Applicants respectfully request reconsideration of the rejection.

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CONCLUSION

For the above reasons, Applicants believe the specification and claims are now in proper form, and that the claims all define patentably over the prior art. Applicants respectfully submit that this application is now in condition for allowance. Should the Examiner have any questions or comments, the Examiner is cordially invited to telephone the undersigned Attorney of record to expedite the prosecution of this case.

Respectfully submitted,
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